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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/571,741

10/19/2006

David R. Forester

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1220

26645

7590

01/25/2010

THE LUBRIZOL CORPORATION  
ATTN: DOCKET CLERK, PATENT DEPT.  
29400 LAKELAND BLVD.  
WICKLIFFE, OH 44092

EXAMINER

HINES, LATOSHA D

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/571,741	<b>Applicant(s)</b> FORESTER ET AL.	
	<b>Examiner</b> LATOSHA HINES	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 06, 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over LAL (EP 0626442).

With respect to claims 1-17 LAL et al. discloses a major amount of a fatty carboxylic acid ester composition from the transesterification of at least one naturally occurring triglyceride (rapeseed oil) (page 4 lines 10-15) and a pour point depressant. The alcohol utilized in forming the transesterified esters are an aliphatic group that contains from 1 to about 24 carbon atoms such as methyl alcohol (page 4 lines 32-36). The pour depressant comprises one or more esterified copolymer of an alpha-olefin or styrene and an alpha, beta-unsaturated

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monocarboxylic or dicarboxylic acid or maleic anhydride, wherein the copolymer is esterified with a mixture of a relatively high molecular weight alcohol (at least 8 carbon atoms) and a relatively low molecular weight alcohol (no more than 7 carbon atoms). Lal discloses the average carbon length through examples of constituent (B) are in the range of 7.9 to 14.1. The ratio of the high molecular weight alcohol to low molecular weight alcohol is within the range of from 2:1 to 9:1 (page 7, line 1- page 8, line 54). The discovery of an optimum value of a known result effective variable, without producing any new or unexpected results, is within the ambit of a person of ordinary skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980) (See MPEP § 2144). The pour point depressant is an ester of a carboxy-containing interpolpolymer, having a reduced specific viscosity of from about 0.5 to about 2 (page 7 lines 3-5). The interpolpolymerizable comonomers include methyl methacrylate (page 8 lines 38-40). The carbonyl polyamino groups include those derived from polyamino compounds having one primary or secondary amino group (page 8 lines 4-5). The fuel composition comprises a major amount of liquid fuel wherein the fuel comprises a petroleum distillate and diesel fuel (page 2 lines 6-10 and claim 14).

### ***Response to Arguments***

4. Applicants' arguments filed 29 July 2009 have been fully considered but they are not persuasive.
5. Applicants argued the reference applied under 35 USC 103, LAL (EP 0626442) fails to explicitly or implicitly teach the specific average carbon length of 10.4 to 11.6 on

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a weight % basis. The Examiner disagrees. LAL discloses the claimed invention except for average carbon length. However it would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied the average carbon chain lengths since it was known in the art that using the same mixtures would have an average carbon length falling within the realm of the presently claimed average carbon length. Applicants set forth on page 2 of remarks mixtures of alcohols used to esterify the copolymer which fall within the claimed range, listed below.

<u>Example in Lal</u>	<u>Average Carbon Length</u>
B-1, B-2, B-3, B-4, B-5, B-6, B-7	14.1
B-8	11.8
B-9	11.7
B-10	14.8
B-11	7.9

6. The examiner is of the position that the average carbon length of 11.7 set forth in Example B-9 of LAL does not differ from the average carbon chain length of 11.6 of the claims. It is the examiners position that obviousness still exist because the ranges are close enough (0.1 carbon chain length difference) that one would not expect a difference in properties. *In re Woodruff* 16 USPQ 2d 1934 (Fed Cir 1990); *Titanium Metals Corp. v. Banner* 227 USPQ 773 (Fed Cir 1985) and *In re Aller* 105 USPQ 233 (CCPA 1955).

7. Applicants further argue that the Examples in the specification demonstrate superior performance in the form of lower cold filter plugging points with copolymers having average carbon chain lengths within the claimed range. This is not deemed to

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be persuasive because, as set forth above, LAL sets forth an example with the claimed average carbon chain length (11.7) for copolymer component B. Further, the results in the specification are not commensurate in scope with the degree of protection sought by the claims, of any and all such "esterified copolymer of an alpha-olefin or styrene and an alpha, beta-unsaturated dicarboxylic acid or anhydride".

8. Although the reference does not literally define the average carbon length, this does not preclude alcohols in LAL from having these characteristics. In view of this, it can be reasonably interpreted that the claimed average carbon length are encompassed by the broad teachings according to this reference in the absence of any evidence showing the contrary. In addition, the desired carbon lengths are functions of the application mere recitation of these do not represent a patentable distinction over this reference to one of ordinary skill in the art, lacking evidence of the contrary.

9. The examiner is of the position a reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545,549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968). In addition, "A reference can be used for all its realistically teachings and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LATOSHA HINES whose telephone number is 571-270-5551. The examiner can normally be reached on Monday thru Thursday from 8 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Marcheschi can be reached on 571-272-1374. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LATOSHA HINES/  
Examiner, Art Unit 1797

/Ellen M McAvoy/  
Primary Examiner, Art Unit 1797